

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GERALD L. FORGET

Appeal No. 1999-0946
Application No. 08/693,641¹

ON BRIEF

Before FRANKFORT, MCQUADE, and NASE, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

¹ Application for patent filed August 9, 1996.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 7², all of the claims pending in this application.

BACKGROUND

Appellant's invention relates to a hot fillable plastic container and more particularly, relates to an improved neck structure for hot fillable plastic containers. As noted on pages 2 and 3 of the specification, while the body of the Prior Art container seen in Figures 1-2 is capable of withstanding temperatures of the hot product during filling, by virtue of biaxial and radial stretching, the neck of the container, which has not been subjected to stretching, softens during the filling, leading to distortion of the threads. The preferred embodiment of appellant's invention seen in Figures 3-4 includes a hot fillable container formed of a blow moldable polymeric material, the neck of the container including an inner wall (38) and a spaced-apart outer wall (40) wherein a gap (42) is provided therebetween. As noted on page 5 of the specification, the gap (42) provides an air space insulation between the inner and outer walls. Once the container has been filled and capped, a seal is formed between the inner wall and cap

²Claim 6 has been amended subsequent to final rejection.

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and an air space is present within the gap, acting as an insulating barrier which minimizes heat migration into the outer wall and threads. Independent claims 1 and 6 are representative of the subject matter on appeal and a copy of these claims can be found in the Appendix to appellant's brief.

The prior art references relied upon by the examiner in rejecting the appealed claims are:

Hall	1,423,560	July 25, 1922
Orimoto et al. (Orimoto)	5,447,766	Sept. 5, 1995

As stated in the final rejection (Paper No. 6), claims 1 through 7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Orimoto in view of Hall.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the final rejection (Paper No. 6, mailed February 27, 1998) and the examiner's answer (Paper No. 11, mailed August 3, 1998) for the examiner's complete reasoning in support of the rejection, and to the appellant's brief (Paper No. 10, filed June 4, 1998) and reply brief (Paper No. 12, filed August 24, 1998) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art references and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we have made the determinations which follow.

Looking at page 3 of the brief, we note that appellant has indicated that claims 1 to 5 stand together, and that independent claim 6 is separately patentable, as is dependent claim 7. Thus, we focus our discussions below on independent claims 1 and 6, as well as on dependent claim 7. Dependent claims 2-5 will stand or fall with independent claim 1.

Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. See In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is prima facie obvious must be supported by

evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art.

The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

With this as background, we turn to the rejection of the claims on appeal.

In rejecting claim 1, the examiner has taken the position that Orimoto teaches a preform that may be made of various plastic materials including polyethylene naphthalate or polyethylene terephthalate and which is blow molded to form a bottle. The preform has a threaded outer surface for receiving a closure. However, Orimoto does not teach the claimed spaced inner and outer walls with a gap therebetween. Hall teaches a molded

glass bottle that has spaced inner and outer walls with a gap therebetween for receiving a ticket. The examiner maintains that it would have been obvious to one of ordinary skill in the art at the time of the invention to make the neck of Orimoto's plastic preform with inner and outer walls and a gap therebetween as taught by Hall so that the bottle neck may hold a ticket.

Like appellant (brief, pages 5 through 10), we agree that there is no teaching, suggestion or motivation found in either of the applied references to make such a modification in the plastic preform of Orimoto. While it would be seemingly possible to add such a channel or gap to the neck of Orimoto's container and preserve its intended function, there is no suggestion in either reference to do so. Hall placed the channel in the neck of the reusable glass bottle so that a milkman would not have to retrieve the ticket from the bottom of the container where it might otherwise become stuck leading to the probability that the bottle would be broken in attempts to retrieve the ticket. Orimoto's container, on the other hand, is formed from a blow moldable plastic which is tolerant of high temperatures, thereby resisting distortion of the threads in the neck area. It is well-known that plastic containers were developed for their convenient disposability and/or recycling, as well as for the safety aspect that they would not break if mishandled. Clearly, the problem confronted by Hall of avoiding breakage of a reusable glass milk container is

not contemplated by the Orimoto reference. Indeed, given the disparate nature of the bottles disclosed in Orimoto and Hall, it is our view that in searching for an incentive for modifying the plastic bottle of Orimoto, the examiner has impermissibly drawn from appellant's own teachings and fallen victim to what our reviewing Court has called "the insidious effect of a hindsight syndrome wherein that which only the inventor has taught is used against its teacher." W. L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983). Since we have determined that the examiner's conclusion of obviousness is based on hindsight reconstruction using appellant's own disclosure as a blueprint to arrive at the claimed subject matter, it follows that we will not sustain the examiner's rejection of appealed claim 1 over Orimoto in view of Hall.

Since the teachings and suggestions found in the Orimoto and Hall references would not have made the subject matter as a whole of claim 1 on appeal obvious to one of ordinary skill in the art at the time of appellant's invention, we must refuse to sustain the examiner's rejection of claim 1 and dependent claims 2-5 under 35 U.S.C. § 103(a).

The rejection of claim 7, which is dependent on claim 3 (which in turn depends on claim 1) will also not be sustained for the same reasons set forth above.

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Independent method claim 6 recites the steps of injection molding a preform having a neck portion and forming said neck to have an inner neck wall and an outer neck wall, wherein said inner neck wall and said outer neck wall are spaced apart to provide a gap therebetween. Again, since we find no teaching, suggestion or incentive in the prior art applied by the examiner for providing the hot fillable plastic bottle/preform of Orimoto with a groove for a ticket like that present in the reusable glass bottle of Hall, we must also refuse to sustain the rejection of claim 6 based on Orimoto in view of Hall.

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The decision of the examiner to reject claimes 1-7 under 35 U.S.C. § 103(a) based
on Orimoto and Hall is reversed.

REVERSED

CHARLES E. FRANKFORT
Administrative Patent Judge

JOHN P. MCQUADE
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

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REVERSED

Prepared: July 24, 2000